

REMARKS/ARGUMENTS

This Reply is filed in response to the non-final Office Action dated July 7, 2011. In the Office Action, Claims 1-3, 7-15, 18, and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,344,796 to Ogilvie et al. ("*Ogilvie*") in view of U.S. Published Patent Application 2002/0130065 to Bloom ("*Bloom*") in further view of U.S. Published Patent Application 2003/0037009 to Tobin et al. ("*Tobin*") and U.S. Patent 6,976,090 of Ben-Shaul et al. ("*Ben-Shaul*"). Claims 16-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ogilvie* in view of *Bloom*, *Tobin*, and *Ben-Shaul*, in further view of U.S. Published Patent Application 2004/0211834 to Fleckenstein et al. ("*Fleckenstein*"). The listed rejections are addressed below. For the Examiner's reference, Claims 20-86 were previously withdrawn in response to a restriction requirement, and Claims 4-6 were previously canceled. Claims 1-3 and 7-19 remain currently pending in the application for the Examiner's consideration.

Independent Claim 1

Independent Claim 1 has been rejected as being unpatentable over *Ogilvie*, in view of *Bloom*, and in further view of *Tobin* and *Ben-Shaul*. Applicants respectfully submit that *Ogilvie*, *Bloom*, *Tobin*, and *Ben-Shaul*, alone or in combination, fail to teach or suggest each and every feature recited in Claim 1. For instance, Applicants had previously amended Claim 1 to recite providing a customer with a web browser enhancement tool that resides in the customer's browser and is configured to provide a digital wallet that is configured to allow the customer to purchase credits, the credits being used to pay a fee to the alternate delivery location service provider each time the customer elects to use the ADL as a shipping location. On pages 8 and 9, the Office Action alleges paragraphs [0045] and [0052] of *Tobin* disclose the digital wallet as recited in Claim 1. Applicants respectfully disagree.

Tobin describes a system that can divert a user's package to a new delivery location upon receipt of a redirection request. *See* Abstract. The system of *Tobin* interfaces with a user via a personal transaction device (PTD). *See* ¶ [0038]. This device may be a privacy card coupled to

a digital wallet, and the device is used to maintain the privacy of the user. *Id.* Paragraph [0045] of *Tobin* explains that the PTD has a unique identifier (ID) and includes either the privacy card and/or the digital wallet. Paragraph [0052] of *Tobin* provides a configuration of the digital wallet, as shown in FIG. 6, that includes a coupling input for the privacy card, processor, memory, input/output logic, display, and peripheral port. Paragraph [0052] of *Tobin* further explains that the processor is configured to execute instructions to perform functionality and that the memory may store data including financial information, eCoupons, shopping lists, and the like. In addition, the digital wallet is coupled to the privacy card through a port or another form of connection such as a wireless connection. *See* ¶ [0053]. Thus, the digital wallet described in *Tobin* is a stand-alone physical device that has a coupling input, processor, memory, display, and peripheral port, which may be coupled to a privacy card.

Applicants respectfully submit, besides both being called a “digital wallet,” the digital wallet described in *Tobin* has nothing in common with the digital wallet recited in Claim 1. Firstly, the digital wallet recited in Claim 1 is provided through a web browser enhancement tool that resides in the customer’s browser. The digital wallet described in *Tobin* does not reside in such a tool. As shown above, the digital wallet described in *Tobin* is a device that has a coupling input, processor, memory, display, and peripheral port. Secondly, the digital wallet recited in Claim 1 is configured to allow the customer to purchase credits to be used to pay a fee to the alternate delivery location service provider each time the customer elects to use the ADL as a shipping location. Nothing in *Tobin* discloses or suggests the digital wallet described in *Tobin* is used for such a purpose.

Instead, the digital wallet described in *Tobin* is used to perform transactions with vendors. *Tobin* describes a secure transaction system that incorporates the functions of a transaction privacy clearing house (TPCH). *See* ¶ [0037]. As explained in paragraph [0038] and shown in FIG. 4 of *Tobin*, the TPCH interfaces a user and a vendor, and the personal transaction device (PTD), that includes a privacy card coupled to the digital wallet, is used to maintain the privacy of the user while enabling the user to perform transactions with the vendor. During a transaction, the vendor receives transaction device information instead of the user’s personal information in order to maintain confidentiality of the user. *See* ¶ [0039]. Thus, as described in

paragraph [0039] of *Tobin*, the digital wallet of *Tobin* is used in conjunction with performing transactions between the user and the vendor, such as purchasing products, not to be used to allow the purchase of credits used to pay a fee for the use of the alternate delivery location as a shipping location.

Such use of the digital wallet described in *Tobin* is recognized in the Office Action on page 9, which states “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Unattended Package Delivery cross-docking apparatus and method of Ogilvie and the method and system for bulk package delivery of Bloom with the digital wallet of Tobin because it provides an efficient means for personal point of sale transactions to include ecoupons, etc.[sic] with a secure transaction system.” Emphasis added. Thus, the Office Action recognizes the digital wallet described in *Tobin* is used to facilitate transactions between the user and the vender, and is not used to allow the purchase of credits used to pay a fee for the use of the alternate delivery location as a shipping location.

Finally, *Ogilvie*, *Bloom*, and *Ben-Shaul* fail to overcome the deficiencies of *Tobin* as none of these references even make mention of a digital wallet. Thus, for at least these reasons, Applicants respectfully submit *Ogilvie*, *Bloom*, *Tobin*, and *Ben-Shaul*, alone or in combination, fail to teach or suggest each and every feature recited in Claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the current rejection of Claim 1 under § 103(a).

Dependent Claims 2-3 and 7-19

Dependent Claims 2-3 and 7-19 have been rejected as unpatentable over various combinations of *Ogilvie*, *Bloom*, *Tobin*, *Ben-Shaul*, and *Fleckenstein*. Claims 2-3 and 7-19 depend from independent Claim 1 and, therefore, include all the features of Claim 1 plus additional features that further define the invention over the cited references. Accordingly, for at least the reasons set forth above with regard to independent Claim 1 and the additional features that further define the invention over the cited references, Applicants respectfully submit that these claims are also in condition for allowance. Therefore, Applicants respectfully request the Examiner to withdraw the current rejection of these claims under § 103(a).

Application No.: 10/696,180
Filing Date: October 28, 2003
Response to Non-Final Office Action dated July 7, 2011

Conclusion

The foregoing is submitted as a full and complete response to the non-final Office Action dated July 7, 2011. The foregoing arguments and remarks are believed to have placed the present application in condition for allowance, and such action is respectfully requested. The Examiner is encouraged to contact Applicants' undersigned attorney at telephone no. (404) 881-7640 or at e-mail address chris.haggerty@alston.com to resolve any remaining issues in order to expedite examination of the present application.

The patentability of the independent claim has been argued as set forth above, and thus, Applicants will not take this opportunity to argue the merits of the rejection with regard to each dependent claim. However, Applicants do not concede that the dependent claims are not independently patentable and reserve the right to argue the patentability of the dependent claims at a later date if necessary.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/Christopher S. Haggerty/

Christopher S. Haggerty
Registration No. 58,100

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON SEPTEMBER 27, 2011.